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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,594

05/17/2006

Antonio Buxade Vinas

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07/28/2010

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 W. MADISON STREET
SUITE 3800
CHICAGO, IL 60661

EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

07/28/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/579,594	VINAS ET AL.	
	Examiner	Art Unit	
	Taylor Victor Oh	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 3,7 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-17 and 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/19/10 has been entered.

The Status of Claims

Claims 1-24 are pending.

Claims 1-2,4-6,8-17,19-24 are rejected.

Claims 3,7,18 are withdrawn from consideration .

Priority

2. It is noted that this application is a 371 of PCT/ES04/00511(November 17 , 2004), which has a foreign priority document, Spain P200302806 (11/28/2003).

The Specification

The specification is objected to because of the following informalities:

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The amendment filed on 12/22/09 for the specification has introduced new paragraphs on page 4, after line 22: “

Those described hydroxyl protective groups are ethers, esters, and, for 1,2- and 1,3-DIOLS, cyclic acetals and ketals and cyclic ortho esters.

The ethers include:

Methyl

Substituted Methyl Ethers

Methoxymethyl (MOM Group)

Methylthiomethyl (MTM Group)

Benzylloxymethyl

t-Butyloxymethyl

2-Methoxyethoxymethyl (MEM Group)

2,2,2-Trichloroethoxymethyl

Bis(2-chloroethoxy)methyl

2-(Trimethylsilyl)ethoxymethyl

Tetrahydropyranyl (THP Group)

3-Bromotetrahydropyranyl

Tetrahydrothiopyranyl

4-Methoxytetrahydropyranyl

4-Methoxytetrahydrothiopyranyl

4-Methoxytetrahydrothiopyranyl S,S-Dioxido

Tetrahydrofuranyl

Tetrahydrothiofuranyl

Substituted Ethyl Ethers

1-Ethoxyethyl

1-Methyl-1-methoxyethyl

1-(Isopropoxy)ethyl

2,2,2-Trichloroethyl

2-(Phenylselenyl)ethyl

t-Butyl

Allyl

Cinnamyl

p-Chlorophenyl

Benzyl

p-Methoxybenzyl

o-Nitrobenzyl

p-Nitrobenzyl

p-Halobenzy

p-Cyanobenzy

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3-Methyl-2-picolyl N-Oxido
 Diphenylmethyl
 5-Dibenzosuberyl
 Triphenylmethyl
 α -Naphthylidiphenylmethyl
 p-Methoxyphenyldiphenylmethyl
 p-(*p*'-Bromophenacyloxy)phenyldiphenylmethyl
 9-Anthryl
 9-(9-Phenyl)xanthenyl
 9-(9-Phenyl-10-oxo)anthryl (Tritylone Group)
 Benzisothiazolyl *S,S*-Dioxido

Silyl Ethers

Trimethylsilyl (TMS Group)
 Triethylsilyl
 Isopropyldimethylsilyl
t-Butyldimethylsilyl (TBDMS Group)
 (Triphenylmethyl)dimethylsilyl
t-Butyldiphenylsilyl
 Methyl*i*isopropylsilyl
 Methyl*di-t*-butylsilyl
 Tribenzylsilyl
 Tri-*p*-xylylsilyl
 Triisopropylsilyl
 Triphenylsilyl

The esters include:

Formate
 Benzoylformate
 Acetate
 Chloroacetate
 Dichloroacetate
 Trichloroacetate
 Trifluoroacetate
 Methoxyacetate
 Triphenylmethoxyacetate
 Phenoxyacetate
 p-Chlorophenoxyacetate
 2,6-Dichloro-4-methylphenoxyacetate
 2,6-Dichloro-4-(1,1,3,3-tetramethylbutyl)phenoxyacetate
 2,4-Bis(1,1-dimethylpropyl)phenoxyacetate
 Chlorodiphenylacetate
 p- \oplus -Phenylacetate
 3-Phenylpropionate
 3-Benzoylpropionate

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Isobutyrate
Monosuccinoate
4-Oxopentanoate (Levulinate)
Pivaloate
Adamantoate
Crotonate
 4-Methoxycrotonate
(*E*)-2-Methyl-2-butenate (Tigloate)
Benzoate
 o-(Dibromomethyl)benzoate
 o-(Methoxycarbonyl)benzoate
 p-Phenylbenzoate
 2,4,6-Trimethylbenzoate (Mesitoate)
 p- \odot -Benzoate
 α -Naphthoate

Carbonates

Methyl
Ethyl
2,2,2-Trichloroethyl
Isobutyl
Vinyl
Allyl
Cinnamyl
p-Nitrophenyl
Benzyl
 p-Methoxybenzyl
 3,4-Dimethoxybenzyl
 o-Nitrobenzyl
 p-Nitrobenzyl
S-Benzyl Thiocarbonate

Miscellaneous

N-Phenylcarbamate
N-Imidazolylcarbamate
Borate
Nitrate
N,N,N',N'-Tetramethylphosphorodiamidate
2,4-Dinitrophenylsulfenate

For protection of 1,2- and 1,3-DIOLS, the cyclic acetals and ketals include:

Methylene
Ethylidene
 1-*t*-Butylethylidene
 1-Phenylethylidene

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2,2,2-Trichloroethylidene
Acetonide (Isopropylidene)
Butylidene
Cyclopentylidene
Cyclohexylidene
Cycloheptylidene
Benzylidene
 p-Methoxybenzylidene
 2,4-Dimethoxybenzylidene
 p-Dimethylaminobenzylidene
 o-Nitrobenzylidene
 p- \odot -Benzylidene
Phenanthrylidene Derivative:

whereas the cyclic ortho esters include:

Methoxymethylene
Ethoxymethylene
Dimethoxymethylene
1-Methoxyethylidene
1,2-Dimethoxyethylidene
 α -Methoxybenzylidene
1-(*N,N*-Dimethylamino)ethylidene Derivative
 α -(*N,N*-Dimethylamino)benzylidene Derivative
Disiloxanylidene Derivative
Stannoxane Derivative
Cyclic Carbonates
Cyclic Boronates
Phenyl Boronate
p- \odot -Phenyl Boronate

However, the newly introduced paragraphs are not literally present and shown in the original specification. A close inspection of the original claims and specification do not provide antecedent basis for the proposed changes. New matter can not be introduced into specification at any time during the prosecution, unless there is a supporting description that would support the proposed changes. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

Claims 1-2, 4-6,8-17,19-24 are objected to because of the following informalities:

In Claim 1, the new phrase “selected from ethers, ester, cyclic acetals and ketals, and cyclic ortho ester” is introduced before the phrase “a hydroxyl protective group” .

However, the newly introduced phrases “selected from ethers, ester, cyclic acetals and ketals, and cyclic ortho ester” are not literally present and shown in the original specification. A close inspection of the original claims and specification do not provide antecedent basis for the proposed changes. New matter can not be introduced into specification at any time during the prosecution, unless there is a supporting description that would support the proposed changes. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 4-6,8-17,19-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In Claim 1, the new phrase “selected from ethers, ester, cyclic acetals and ketals, and cyclic ortho ester” after the phrase “a hydroxyl protective group” is recited. This phrase has not been literally present in the original specification (see page 10 ,line 23; page 11, line 4, and page 17, lines 18-19). Therefore, the addition of the newly introduced phrases “selected from ethers, ester, cyclic acetals and ketals, and cyclic ortho ester” to the claim does not provide antecedent basis for the proposed changes. A close inspection of the original claims and specification do not provide antecedent basis for the proposed changes. New matter can not be introduced into specification at any time during the prosecution, unless there is a supporting description that would support the proposed changes. Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 1-2, 4-6,8-17,19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 6, 20-21, the variables Z' and R are recited in the limitation. These are vague and indefinite because the formulas (I), (A2),and (A3) do not contain those variables. Therefore, an appropriate correction is required.

Applicants' Argument

3. Applicants argue the following issues:

i.

In short, legally and logically, the reference to the TW Green book in the present U.S. National Stage application should be recognized as being sufficient to "[e]xpress a clear intent to incorporate by reference", 37 C.F.R. 1.57(b)(1), even though the root words "incorporat(e)" and "reference" were not used. As stated in 37 C.F.R. 1.57(g)(1), "[a] correction to comply with [37 C.F.R. 1.57(b)(1)] is permitted only if the application as filed clearly conveys an intent to incorporate the material by reference."

ii.

In short, Dr. Peypoch's Declaration clearly supports the factual conclusion, consistent with the logical legal support provided by Mr. Petersen's Declaration, that the amendment to the specification merely adds exactly what was incorporated by reference in the original application(s), and thus that amendment cannot and does not constitute new matter. Correspondingly, claim 1 is similarly definite under 35 U.S.C. 112 in its recitation of the "hydroxyl protective group".

Applicants' arguments have been noted, but the arguments are not found to be persuasive.

Regarding the first and second arguments, the Examiner has noted applicants' arguments. However, regardless of filing both declarations, applicants have admitted that the original specification lacks the language of "incorporated by reference"; the U.S. practices in the PTO require the very presence of that particular literal language without interpreting any particular passages. Thus, it seems very difficult to assume that there is no clear intent on applicants' part.

The MPEP clearly states the following rules and regulations:

I. INCORPORATION BY REFERENCE

>37 CFR 1.57. *Incorporation by reference.*

(a) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under § 1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

(1) The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114 (b), or abandonment of the application, whichever occurs earlier. The applicant is also required to:

(i) Supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111;

(ii) Supply an English language translation of any prior-filed application that is in a language other than English; and

(iii) Identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

(2) Any amendment to an international application pursuant to this paragraph shall be effective only as to the United States, and shall have no effect on the international filing date of the application. In addition, no request to add the inadvertently omitted portion of the specification or drawings in an international application designating the United States will be acted upon by the Office prior to the entry and commencement of the national stage (§ 1.491) or the filing of an application under 35 U.S.C. 111 (a) which claims benefit of the international application.

(3) If an application is not otherwise entitled to a filing date under § 1.53(b), the amendment must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f).

(b) Except as provided in paragraph (a) of this section, an incorporation by reference must be set forth in the specification and must:

(1) Express a clear intent to incorporate by reference by using the root words “incorporat(e)” and “reference” (*e.g.*, “incorporate by reference”); and

(2) Clearly identify the referenced patent, application, or publication.

(c) “Essential material” may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference. “Essential material” is material that is necessary to:

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(1) Provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by the first paragraph of 35 U.S.C. 112;

(2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. 112; or

(3) Describe the structure, material, or acts that correspond to a claimed means or step for performing a specified function as required by the sixth paragraph of 35 U.S.C. 112.

(g) An incorporation of material by reference that does not comply with paragraphs (b), (c), or (d) of this section is not effective to incorporate such material unless corrected within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. In addition:

Furthermore, the following clause is especially applicable to the present situation of the prosecution of the application:

(c) "Essential material" may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference.

Those information incorporated by reference are considered as **essential materials** to the claimed invention since they are claimed in the claim section. A close inspection of the original claims and specification do not provide antecedent basis for the proposed changes. New matter can not be introduced into specification at any time during the prosecution, unless there is a supporting description that would support the proposed changes. The examiner recommends to cancel all the new matters in the reply to this Office Action since the original 112 second rejection based on the phrase "a hydroxyl protective group" has been resolved by applicants' remarks in the previous communication.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Taylor Victor Oh/

Primary Examiner, Art Unit 1625

7/27/10